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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,774	11/09/2001	Adrian Benetti	P07430US00/WEJ	5632
881	7590	08/23/2004	EXAMINER	
STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			BOYD, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/986,774	Applicant(s) BENETTI, ADRIAN	
	Examiner Jennifer A Boyd	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed June 10, 2004, have been entered and have been carefully considered. Claims 1, 7 and 12 are currently amended, claims 5 – 6, 8 – 11 and 15 – 47 are cancelled and claims 1 – 4, 7 and 12 – 14 are pending. In view of Applicant's Amendments, the Examiner withdraws the 35 U.S.C. 112 rejections as detailed in paragraphs 3 – 5 of the previous Office Action. In view of Applicant's Amendments, the Examiner withdraws all previously set forth rejections as details in paragraphs 6 – 9 of the previous Office Action dated September 25, 2003. Despite these advances, the invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sosnowski (US 5,889,229) in view of Benn, Jr. (US 6,613,976).

Sosnowski is directed to a self-terminating, knitted, metallized yarn EMI/RFI shielding gasket (Title). It should be noted that the Examiner has given no patentable weight to "a flat low friction cord, noise and dampening cord". Furthermore, it has been held that a recitation with respect to the manner in which a claimed article is intended to

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be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

As to claim 1, Sosnowski teaches a core, a first tubular layer and a second tubular layer (Abstract). Sosnowski teaches that the core can have a cross-sectional shape such as oval, elliptical and rectangular (column 3, lines 15 – 19). It is the position of the Examiner that elliptical is considered to be a flattened shape and similarly, a rectangular core has flat surfaces which would result in a flat core. Sosnowski teaches that the core can be made of foamed elastomers, composite materials, polymers and other resilient non-elastomeric materials (column 3, lines 34 – 39). Sosnowski specifically teaches the use of a polyurethane foam (column 3, line 30). The Examiner equates the core to Applicant's "substantially flat core". The second tubular layer, equated to Applicant's "knitted cover", is preferably knit (column 4, lines 10 – 11). The second tubular layer entirely covers the core as seen in Figures 2 – 7.

As to claim 2, Sosnowski teaches shows in Figure 1 that the yarn is more oriented, or straight and in alignment, in the direction of the gasket than the transverse direction.

As to claim 4, Sosnowski teaches that the second tubular layer, or "knitted cover", is made of yarns comprising *filaments*. When multiple filaments are present in a yarn, the filaments must be twisted in either an S or Z direction to create an effective yarn.

As to claim 7, Sosnowski teaches in Figure 1 that the second tubular layer, or "knitted cover", covers the core.

As to claim 13, Sosnowski teaches that the core is surrounded by a first tubular layer which is made of hot melt adhesive yarn in a knitted form or can be replaced with other adhesive products (column 3, lines 55 – 67).

As to claim 14, Sosnowski teaches that the adhesive is activated by heat and has a quick set time (column 3, lines 55 – 65). Sosnowski teaches that after the melting of the adhesive, the second tubular member, or “knitted cover”, is adhered to the core and longitudinal movement is prohibited (column 4, lines 50 – 60).

As to claims 1 and 12, Sosnowski fails to teach that the core can be made of polyvinyl chloride (PVC) as required by claim 1, and more specifically, an extruded foamed polyvinyl chloride as required by claim 12.

Benn, Jr. teaches an electromagnetic interference shielding gasket (Title). Benn, Jr. teaches that the gasket is made from an easily compressible extruded foam or sponge (column 3, lines 19 – 22). Specifically, Benn, Jr. teaches the use of a foamed polyurethane or polyvinyl chloride (PVC) (column 3, lines 55 – 63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the foamed polyvinyl chloride of Benn, Jr. in the core of the gasket of Sosnowski motivated by the suggestion that foamed polyurethane has similar properties to foamed polyvinyl chloride and can be interchanged with foamed polyvinyl chloride as the core in gaskets.

As to claim 1, Sosnowski in view of Benn, Jr. discloses the claimed invention except for that the yarns have a denier of 1500. It should be noted that denier is a result

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effective variable. For example, as the denier increases, the knitted material becomes more rigid and the strength increases. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a “knitted cover” with yarns having a denier of 1500, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to optimize the denier to create a strong yet flexible gasket.

As to claim 3, Sosnowski in view of Benn, Jr. discloses the claimed invention except for that the yarns comprising the “knitted cover” extend in a continuous zigzag pattern. It would have been obvious to one having ordinary skill in the art at the time the invention was made to create the “knitted cover” with a zigzag pattern since it has been held to be within the general skill of a worker in the art to select a pattern based on the desired aesthetics and end use of the product.

Response to Arguments

4. Applicant's arguments filed June 10, 2004 have been fully considered but they are not persuasive.

5. In response to the argument that the choice of denier is not a consequence of optimization, the Examiner respectfully argues the contrary. Sosnowski is directed to a self-terminating, knitted, metallized yarn EMI/RFI shielding gasket (Title) in which the knitted layer has a metallized yarn denier range of 70 – 300 (column 4, lines 20 – 25). The Applicant requires that the yarn has a denier of 1500. It would have been obvious based on the intended use of the Sosnowski invention to optimize the yarn denier to 1500

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to create a stronger and more rigid knitted structure. It should be noted that the Examiner is not optimizing the denier of a knitted material in a noise and vibration dampening cord but instead for a knitted material in a EMI/RFI shielding gasket.

6. In response to the argument that Sosnowski and Benn, Jr. which are drawn to electromagnetic shielding gaskets would not serve as appropriate prior art, the Examiner respectfully argues the contrary. It should be noted that beyond the intended use statement of “a flat, low friction, noise and vibration dampening cord”, Sosnowski in view of Benn, Jr. meet each and every structural limitation provided in the claims. It has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). It is suggested to the Applicant to further define the invention by adding physical limitations in the claim that would differentiate it from Sosnowski and Benn, Jr. such as the composition of the knitted yarn; it should be noted that Sosnowski teaches a metallized yarn.

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Conclusion

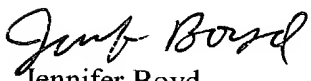
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer Boyd
August 17, 2004


Ula C. Ruddock
Primary Examiner
Tech Center 1700